Supreme Court, U. S.
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IN THE

Supreme Court of the United States

October Term, 1977

No. 78-

77-1223

SUPER ATHLETICS CORPORATION and

DONALD E. PINCHOCK,

Petitioners,

v.

UNIVERSAL ATHLETIC SALES COMPANY,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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SUPREME COURT OF THE UNITED STATES

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No. 78-

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DONALD E. PINCHOCK,

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v.

UNIVERSAL ATHLETIC SALES COMPANY,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

Petitioners respectfully pray that a writ of certiorari issue to review the judgment order of the United States Court of Appeals for the Third Circuit in this case.

OPINIONS BELOW

The judgment order of the Court of Appeals, is set forth in the Appendix at p. 1. The order of January 18, 1977 of the District Court denying Petitioners' Motion for Partial New Trial, from which the appeal to the Circuit Court was taken, is set forth in the Appendix at pp. 4 and 5. The earlier opinion of the Court of Appeals reversing the District Court on the issue of patentability, which is reported at 192 USPQ 193 is set forth in the Appendix at pp. 6-25. The order of the Court of Appeals denying rehearing in banc as to the decision in 192 USPQ 193 is set forth in the Appendix at p. 31. The opinion of the United States District Court for the Western District of Pennsylvania which was reversed in 192 USPQ 193, and which is reported at 397 F. Supp. 1063 (1975) is set forth in the Appendix at pp. 32-63.

JURISDICTION

The judgment of the Court of Appeals is sought to be reviewed was entered December 5, 1977. No petition to the Court of Appeals for rehearing was taken. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTION PRESENTED

Did the Court of Appeals err in refusing to afford Petitioners the opportunity to present a more suitable expert witness where it had reversed a holding of the trial court, favorable to Petitioners, predominately on the ground that it objected to Petitioners' expert witness who testified at the trial, particularly in light of the fact that Petitioners were without warning that the witness was in any way objectionable as the same expert witness had previously testified in another like case without objection and in light of the further fact that Respondent was aware of Petitioners' intention to use this expert witness six months before the trial but raised the issue of his competence

for the first time at the trial causing the trial court to rule the testimony of the expert witness admissible because an unusual hardship had been imposed on the litigants and the court by Respondent's delay in raising the issue?

STATEMENT OF THE CASE

This petition arises from a civil action, filed by Respondent against Petitioners, under Zinken Patent 2,932,509. The case was tried before District Judge William W. Knox on October 29, 30 and 31 and December 12 and 13 of 1974. At issue here is Petitioners' right to present new expert testimony on the disqualification, by the Circuit Court, of the testimony of Firman P. Lyle who testified as Petitioners' patent expert.

Lyle is an associate of Thomas H. Murray, counsel for Petitioners. He is a patent attorney with seven-years experience as a patent examiner in the U.S. Patent Office and thirty-five years experience as a patent attorney for Westinghouse. Lyle's appearance in the trial on the Zinkin patent was not his

first experience as a patent expert. He had testified on behalf of Robicon as an expert without objection in the circuit where this case originated in Ronald S. Orton v. Robicon Corp., et al, 378 Fed. Supp. 930 (1974). Lyle also testified in the Sixth Circuit in Civil Action No. C-74-1087, International Liquid Xtal Co., et al v. F. Hoffmann-LaRoche & Co., Ltd. In the latter case, Lyle was objected to for the same reasons as in the instant case but Judge William D. Thomas of the Northern District of Ohio overruled the objection. To counsel for Petitioners, Lyle was a competent and knowledgeable witness.

Counsel for Respondent had been informed that Lyle was associated with Murray's firm and would appear as a witness about six months before the trial in Petitioners' pretrial statement dated about March 19, 1974. Respondent did not object to Lyle at that time and counsel for Petitioners assumed that Lyle would testify without objection as he had in other cases. But at the trial, for the first time, counsel for Respondent objected to the offer to present Lyle as a witness on the ground that Lyle's association with

Murray presented an ethical problem. The trial court overruled the objections stating (App. 81-82):

> "I think we will permit the witness to testify, but as to what effect this has upon his credibility, that will be up to the court whether this indicates some interest or bias on his part.
>
> "But I don't think, under the circumstances here, we will disqualify him. I think the court has some leeway and discretion in this matter, and I do think that perhaps the problem here is that you knew well in advance. So, it isn't a question about a sudden problem coming up in the middle of the trial in this case. We are quite prone to allow lawyers to testify even as to matters of sharply disputed facts, because, otherwise, it means stopping the trial and starting all over again at some other time.
>
> "But I think, under the circumstances here, we will permit the testimony of this witness under b(4) as being permissible within the discretion of the court. But the weight to be given the testimony under these circumstances will be for the Trier of Fact." (Emphasis added.)

The mention of b(4) in this passage refers to b(4) of the Code of Professional Responsibility: Rules of

Disciplinary Enforcement of the Pennsylvania Bar Association Rule DR 5-101 - Refusing Employment When the Interests of the Lawyer May Impair His Independent Professional Judgment. Clause b(4) is an exception applicable where a hardship would occur. In the instant case a hardship would have occurred. Counsel and their witnesses were assembled and ready to try the case. The granting of the motion would have added to the "laws delay" and to the cost.

Judge Knox held the Zinkin patent invalid. In his opinion he mentions Lyle only once (App. 48):

> "The record does, however, contain opinions by both parties' experts as to obviousness. The court chooses to adopt the view of defendant's expert Firman Lyle."

The Court of Appeals reversed. It held that Judge Knox ruled correctly in admitting Lyle's testimony, but that he erred in giving this testimony

"controlling" weight.* With Lyle's testimony discounted, the Appeals Court held Petitioners' proof inadequate to overcome the presumption of validity of the Zinkin patent albeit that it expressed doubts on this issue of validity. The Court said (App. 21):

> "While there is some doubt whether the differences between the references and the Zinkin claims are so substantial as to defeat the allegation of obviousness, we conclude that the evidence is insufficient to sustain the conclusion of the trial judge that all differences were such as to render the patented device obvious." (Emphasis added.)

and (App. 24, 25):

> "While the validity of the Zinkin patent is not completely free from doubt, we do not accept the decision reached by the district court. The district court erred in according substantial weight to the testimony of Mr. Lyle. Without such unjustified reliance on that testimony, the trial judge could not properly interpret the prior art." (Emphasis added.)

* In this holding that Judge Knox ruled correctly on the law and incorrectly as a trier of fact, the Appeals Court reversed its role as an appellate tribunal, encroaching (cont'd)

That the Appeals Court attached unusual significance to the use of Lyle as an expert is manifest from the repeated reference to Lyle and his testimony (App. 13-18; FN 18-31). Hamlet's comment in Act III, Scene 2, "The lady doth protest too much, methinks" is brought to mind.

The Court of Appeals vacated the judgment of the district court and remanded the cause for proceedings consistent with its opinion. Following remand, Petitioners filed a Motion for Partial New Trial Under Rule 59 (FRCP) before the district court. This Motion was denied (App. 4, 5) and the appeal to the Circuit Court followed. The Appeals Court affirmed the judgment of the district court, without a hearing (App. 1-3), in effect holding that, notwithstanding the circumstances surrounding Lyle's testimony, Petitioners should not be granted an opportunity to present testimony more suitable to the Court of Appeals.

* cont'd
on the domain of the trial court in categorical disregard of Rule 52 FRCP. This Court has granted certiorari where this rule was disregarded. Zenith Radio Corporation v. Haseltine Research, Inc., 396 U.S. 933, 88 S Ct. 1844, 20 L. Ed. 2d 853 - 395 U.S. 100 (1969) at 108.

This Petition is grounded on Supreme Court Rule 191(b). In its action, the Court of Appeals has so far departed from the accepted and usual course of judicial proceedings and from sound administration of justice as to call for an exercise of this Court's power of supervision.

This Court has denied an earlier Petition for Certiorari in this case No. 76-1233, denied April 25, 1977. This Petition was filed while the appeal from the denial of Petitioners' Motion by the district court was pending. That Petition raised the issue as to the validity of the Zinkin patent even disregarding Lyle's testimony. The instant Petition does not raise the issue of validity. It raises only the sole issue whether or not Petitioners, under the circumstances described, are entitled to a partial new trial for the sole purpose of presenting more suitable expert testimony. Adequate expert testimony will then be before the Court to resolve the issue of validity instead of leaving it in limbo. This issue has not heretofore been considered.

REASON FOR GRANTING THE WRIT

Based on the past practice, Petitioners could not have anticipated that Respondent's belated objections to Lyle's testimony would be accorded the significance which the Court of Appeals has given it. Lyle had served as an expert witness while an associate of defense counsel before and either had not been objected to or, when he was, the objection was overruled. The Appeals Court states what procedure Judge Knox should have followed (App. 14, FN 21):

> "Because the action was tried below without a jury, the trial judge could have adjourned the proceedings, without prejudice to the parties or a waste of court resources, until defendants selected another expert or, if they still desired the testimony of Mr. Lyle, another law firm." (Emphasis added.)

The fact is that this procedure was not followed. The cause of justice demands that it be followed in a later trial. Otherwise, Petitioners will suffer a serious injustice in not being afforded an opportunity to fully present their case and Respondent will have benefited

from its delaying tactics and its tactic of springing a surprise on Petitioners will be approved. It was the delaying tactic which precluded deliberate consideration of Lyle's qualification by Judge Knox and caused him to rely on b(4).

The Circuit Court has held that expert testimony is necessary to evaluate the Zinkin patent and the references relied upon to invalidate it. It said (App. 20):

> "In the absence of expert testimony, other than that of Mr. Lyle, the trial judge could not properly appraise the prior art, narrow in scope as it was." (Emphasis added.)

The Circuit Court could no more adjudicate the validity of the Zinkin patent without a proper expert on behalf of Petitioners than could the trial court. The validity of the patent was never really litigated; it was held valid by default on the discarding of Lyle's testimony. The case was decided by the Circuit Court without an ingredient which the same Court has ruled is essential to a rational decision. Petitioners are not accorded

justice unless this case is decided on its merits and to achieve this purpose, Petitioners should be given the opportunity to present expert testimony such as is decreed by the Circuit Court.

This reasoning is basically the reasoning adopted by the Third Circuit in duPont v. United States, 385 F. 2d 780 (CA 3, 1967). In this case, Paterson, an expert witness for the plaintiff, testified as to the post-casualty value of certain property damaged in a hurricane. The testimony was received in evidence; however, after the trial, it was determined by the District Court that the testimony of the expert was unacceptable because it was based on an erroneous legal premise. Paterson had not taken into consideration the future potential of property destroyed by a storm. The District Court, discarding Paterson's testimony, entered judgment for the United States. The Circuit Court remanded to give duPont an opportunity to present additional evidence. The Court said:

> "Plaintiffs were entitled to rely on the record as it was closed, and they could not have anticipated the subsequent rejection of the evidence on the grounds of incompetency. They were thus deprived of the opportunity to supply the deficiency which they would have had if the evidence had been stricken during the course of the trial. In these circumstances, . . . plaintiffs were entitled to an opportunity to offer additional evidence either by further explanation by Paterson or by other witnesses to supply the want of evidence which the court had declared existed. It is always desirable that a litigant's claim should be determined after the presentation of all the relevant evidence. This principle underlies Rule 41 (a) (2) which has been construed to justify a voluntary dismissal without prejudice by a plaintiff even after trial, where the court believes a meritorious claim exists but there has been a technical failure of proof. . . The cause of justice will be advanced with no prejudice to the Government by affording plaintiffs an opportunity to supply the vacuum created by the post-trial determination of a legal insufficiency in their evidence." (Emphasis added.)

The same situation exists here; the Circuit Court has rejected the testimony of Lyle as being based on an erroneous legal premise which could not have been anticipated (i.e., that the opinion evidence of Lyle should

not have been given the weight accorded it by the trial court inasmuch as he is an associate of defense counsel, and is a patent attorney and not a designer of weight-training equipment). While in the duPont case, supra, the District Court held the opinion evidence to be inadmissible after trial, whereas in the present case the Circuit Court did so also after trial, the fact remains that in either case the offering party was wrongly not given an opportunity to present other expert testimony.

The Circuit Court of the Third Circuit manifested a like tendency to put justice before technicalities in Goger v. H. K. Porter Company, Inc., 492 F. 2d 13 (3rd Cir. 1974). In this case, Goger took action under the Age Discrimination in Employment Act before the Department of Labor and the Federal Court in New Jersey without first applying to the state agency under Section 633(b) of ADEA. The district court granted a motion to dismiss. The Circuit Court reversed. The majority of the panel held that Goger should have applied to the state agency but in the case of Goger this requirement would be waived since there had been no

earlier Appeals Court decision so holding. Goger could not have anticipated the holding. The Court said it was granting "equitable relief" in light of the "remedial purposes" of ADEA. Analogous compelling reasons exist here.

C O N C L U S I O N

For reasons here presented, this Court should, in the interest of sound administration of justice, issue a writ of certiorari to review the opinion and judgment order in this case of the Court of Appeals for the Third Circuit.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that three copies each of the foregoing Petition and the appendix have this date been served upon opposing counsel of record by mailing the same by United States mail, postage prepaid and properly addressed.

Date:

Thomas H. Murray
Counsel for Petitioners

APPENDIX

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

Nos. 77-1398-77-1399

UNIVERSAL ATHLETIC SALES CO., a corporation

vs.

AMERICAN GYM, RECREATIONAL & ATHLETIC EQUIPMENT CORPORATION, INC., GRAYSON INDUSTRIES CORP., AMERICAN SUPER GYM CORP. and SUPER ATHLETICS CORPORATION, all corporations; RONALD ARBASEK, an individual; and LARRY SALKELD, DONALD E. PINCHOCK and S. DAVID BROSDKY, individuals, dba SUPER ATHLETICS CORPORATION

SUPER ATHLETICS CORPORATION AND S. DAVID BRODSKY,
Appellants in No. 77-1398

DONALD E. PINCHOCK, Appellant in No. 77-1399

(D. C. Civil No. 71-166)

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

Submitted Under Third Circuit Rule 12(6)
December 2, 1977
Before GIBBONS, VAN DUSEN, Circuit Judges, and GERRY*, District Judge

---

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J U D G M E N T O R D E R

In this appeal from the denial of a motion for a partial new trial under Fed. R. Civ. P. Rule 59 appellants contend that the District Court misconstrued our mandate in Universal Athletic Sales Co. v. American Gym Etc., 546 F.2d 530 (3d Cir. 1976) as precluding

relitigation of the validity of two patent claims. We find no error.

It is O R D E R E D and A D J U D G E D that the judgment of the district court is affirm, and it is further

O R D E R E D that costs shall be taxed in favor of appellee, but that appellee's motion for counsel fees be and is hereby denied.

By the Court,

/s/ John J. Gibbons
Circuit Judge

Attest

/s/ Thomas F. Quinn
Thomas F. Quinn
Clerk

Dated: Dec. 5, 1977

IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF PENNSYLVANIA

UNIVERSAL ATHLETIC SALES CO.	)	
	)	
V.	)	Civil Action No. 71-166
	)	
AMERICAN GYM RECREATIONAL & ATHLETIC EQUIPMENT CORPORATION	)	

ORDER DENYING MOTION FOR PARTIAL NEW TRIAL

AND NOW, to wit, January 18, 1977, upon consideration of defendant's motion for partial new trial filed November 29, 1976 and consideration of the briefs and arguments of counsel thereto,

IT IS ORDERED that the same be and hereby is denied. The court has carefully examined the opinion of the Court of Appeals in this case filed November 19, 1976, together with amendment thereto and determines that the court did not provide for further trial with respect to the issues of patent validity and infringement that the order of the Circuit mandate of which was received January 14, 1977, merely provided for further proceedings in this case with respect to other issues. The court cannot find any indication that the Circuit intended

that the defendant was to be given a further opportunity to put in additional proof to attack this patent or the infringement thereof in the absence of grounds for a new trial for after discovered evidence.

The court is of the opinion that if there is any clarification required of the opinion of the Court of Appeals the same should be sought by a motion to clarify or other proper proceedings in the Circuit.

/s/ William W. Knox
U.S. District Judge

CC: Counsel of record

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

No. 76-1023

UNIVERSAL ATHLETIC SALES CO., a corporation,
Appellant

v.

AMERICAN GYM, RECREATIONAL & ATHLETIC EQUIPMENT CORPORATION, INC., GRAYSON INDUSTRIES CORP., AMERICAN SUPER GYM CORP. and SUPER ATHLETICS CORPORATION, all corporations; RONALD ARBASEK, an individual, and LARRY SALKELD, DONALD E. PINCHOCK and S. DAVID BRODSKY, individuals, dba SUPER ATHLETICS CORPORATION

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

Civil Action No. 71-166

Argued September 9, 1976

Before: ADAMS, ROSENN and GARTH, *Circuit Judges.*

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OPINION OF THE COURT

(Filed November 19, 1976)

ADAMS, *Circuit Judge.*

At issue in this case is the validity of a United States patent [1] that pertains to a weight-lifting apparatus. Originally granted to Harold Zinkin, the patent was owned by Universal Athletic Sales Co. at the time of suit. The patent consists of eight claims, and the district court struck down two of them on grounds of anticipation and obviousness.[2] We must decide whether these rulings were warranted.

Two issues underlie the basic question of patent validity which is before the Court. The first concerns the controlling weight accorded by the trial judge to the testimony of defendants' principal expert witness, an associate in the law firm representing two of the defendants. Assuming that such testimony deserved little or no weight, as plaintiff maintains, we must then decide the second issue, whether there was nonetheless evidence sufficient to support the district court's decision.

I.

Modern technology has, of course, pervaded almost every province of human endeavor. The Zinkin patent demonstrates the verity of this postulate, for it deals with a somewhat unusual activity—weight-lifting. Specifically, the patent relates to the chest-press exercise, one of the cornerstones of the bodily arts. As athletes and physical fitness enthusiasts well know, the chest press enables the

1. United States Letters Patent No. 2,932,509 for "Body Exercising Apparatus," issued on April 12, 1960.

2. The original opinion of the district court is reported at 397 F. Supp. 1063 (W.D. Pa. 1975). That opinion subsequently was amended, and the amendment is, as of this time, unreported. For the amended opinion, see Appendix at 61-63. (Note that the appendix was filed jointly by the parties.)

zealous practitioner to develop the musculature of his upper torso. Like many modern advances, the Zinkin patent attempts to retain the advantages of old methods, while conferring added benefits with the new.

In the traditional chest press, the exerciser lies on a bench and raises a free barbell from his chest to a position in which his arms are fully extended. He raises and lowers the barbell for as long as he desires or is able. The exercise requires the continuing assistance of another person, the "spotter." Not only must the spotter hand the barbell to the exerciser at the inception of the routine, but he must also attempt to retrieve the bar should it begin to totter. Occasionally, the spotter is unable to catch the barbell so that it falls upon the exerciser, causing injury that can be quite serious.

The patent in this appeal discloses an apparatus which permits an exerciser to simulate, safely and effectively, the chest press exercise.[3] To use the patented apparatus, the

3. The claims of the Zinkin patent that are contested by the defendants contain the following descriptions:

"3. A body exercising apparatus comprising an elongated substantially horizontal table having a predetermined head end and a foot end, an elongated bar extended from the head end of the table in substantial alignment therewith and having an end adjacent to the table and an opposite end, means pivotally mounting the extended end of the bar for pivotal movement about a substantially horizontal axis transversely of the table and in spaced relation to the head end thereof whereby elevational movement of the bar causes the end thereof adjacent to the table to describe an arc with its concave side disposed toward the table, a pair of handles aligned transversely of the table, means rigidly mounting the handles on the bar for integral pivotal movement therewith, stop means engageable with the bar limiting downward travel of the handles to positions in upwardly spaced relation to the table, and means connected to the bar resistive to upward pivotal movement thereof."

"4. A body exercising apparatus comprising an elongated substantially horizontal table adapted to support a person in supine position thereon having a predetermined head end and foot end, a framework adjacent to the head end of the table, an elongated bar pivotally mounted in the framework in substantial alignment with the table for movement about a substantially horizontal axis transversely of the table in spaced relation to the head end thereof and said bar being extended toward the table, a pair of handles rigidly mounted on the bar and disposed on opposite sides of the head end of the table, said bar terminating short of the table and leaving the area above the head end thereof free from obstruction, adjustable weight means borne by the bar, and a stop mounted in the framework engageable with the bar limiting downward pivotal movement thereof to a position with the handles disposed at an elevation above the table."

exerciser lies upon a table in a supine position and pushes against handles in an upward movement. These handles shift in an arcuate fashion, analogous to the movement of the bar in the chest press exercise. They extend from a box-like structure which supports and contains the lifting mechanism. The design of the apparatus is such that the handles, the attached bar and the weights cannot strike the exerciser even should he falter. In addition, the Zinkin machine may be utilized without the assistance of a spotter. The patented apparatus thus eliminates the safety hazards posed by the conventional chest press and obviates its manpower requirements as well.[4]

This action was initiated by Universal against the defendants as part of a complex litigation involving, *inter alia*, questions of patent infringement, unfair competition, copyright infringement and antitrust violations. When Universal alleged patent infringement in its complaint, the defendants pleaded invalidity of the patent itself. The district court severed the patent infringement and unfair competition issues for trial,[5] and the patent issue, alone, is before us on appeal. After a nonjury trial, the district court initially adjudged the Zinkin patent entirely invalid. However, an amended order vacated the earlier judgment, leaving as invalid patent claims numbered 3 and 4.

Defendants had developed a body-exercising apparatus very similar to that covered by the Zinkin patent. Indeed,

4. The problems inherent in the simple chest press exercise had spurred several previous attempts at improvement. *See* Brief of Appellants, at 10-14. The "cradle" device, for example, utilized a rack which held the barbell at the beginning and end of the exercise. This primitive apparatus, however, did not eliminate the need for a spotter during the course of the exercise. Moreover, the cradle device was unstable and often flipped over, injuring the exerciser, his spotter or others. Subsequent improvements included the "power rack" and the "verti-slide." While these advances remedied the dangers posed by the chest press, their protective features often proved disruptive to the exercise routine. Consequently, prior to the Zinkin patent, many devotees of the chest press continued to use the free barbell in spite of its perils, inconvenience and added expense. The district court did not consider these primitive improvements as "prior art" with respect to the Zinkin apparatus, nor do any of the defendants.

5. For a report on the related proceedings, see the original district court opinion, 397 F. Supp. at 1065 and n.1.

the district court found that "the defendants' chest press apparatus would infringe the Zinkin patent if the Zinkin patent were not . . ." invalid.[6] In their briefs, defendants list several differences between their own device and that of Zinkin. Nevertheless, the defendants do not vigorously contest the determination of infringement by the trial judge. Instead, they rely solely upon his ruling of invalidity, and attempt to buttress his analysis in this respect. At trial, as in the appeal now before us, the primary focus was on whether the Zinkin patent was "anticipated" or made "obvious" by the prior art.

Two references were relied upon by the district court in holding the Zinkin claims invalid: a patent issued to C. A. Simmons in 1871[7] and a magazine photograph, dated 1950, of a lifting machine designed by Sam Loprinzi.[8] Disclosing a lifting machine for "developing the muscular system," the Simmons device consists of weighted levers which the exerciser apparently lifts and lowers as part of the exercise. The Loprinzi machine is described in the photograph caption as a "super-duper pressing apparatus," but the magazine caption itself provides no information as to the features of the device or how it was to be used. Defendants' principal expert witness attempted to explain its features based solely on his examination of the photograph.

That expert was Firman Lyle, an associate lawyer in the law firm that represented several of the defendents.[9] Controlling weight was given by the district court to his testimony as to obviousness and anticipation: "The court chooses to adopt the view of defendant's expert Firman Lyle."[10] Relying on the Simmons patent, the Loprinzi photograph, and Mr. Lyle's testimony as to these ref-

6. 397 F. Supp. at 1070-71.

7. Patent No. 117,339, dated July 25, 1871, for a "Lifting Machine."

8. The photograph appeared in *Strength and Health* Magazine, May-June 1950, at 50.

9. *See* Appendix at 280 (Trial Transcript at 383).

10. 397 F. Supp. at 1070.

erences, the trial court concluded that the two central claims of the Zinkin patent are void, since they were anticipated and made obvious by prior art.

For reasons to be discussed in this opinion, we have decided that the judgment of the district court must be vacated.[11]

II.

For the district court to grant controlling weight to the testimony of Mr. Lyle constitutes error for two reasons. First, because Mr. Lyle's qualifications as an expert are questionable, at least insofar as this litigation is concerned, the trial judge erred in according great weight to his opinions. Second, the district court committed error in failing to discount the value of the testimony, given the interest in the litigation of the law firm with which Mr. Lyle was associated.

A.

Universal first contends that Mr. Lyle's testimony should have been excluded because he was not an expert with respect to the patent claims at issue here.

This Court previously has delineated the standard which governs the competency of an expert witness in a particular case. As we noted in United States v. 60.14 Acres of Land,[12] an expert witness " 'must have such skill, knowledge and experience in [the] field or calling as to make it appear that his opinion or inference will probably aid the trier in his search for truth.' "[13] Ordinarily, the determination of competency of an expert witness rests

11. This Court has jurisdiction pursuant to 28 U.S.C. § 1292(a)(4), which authorizes an appeal from a district court judgment in a patent infringement action that is final except for an accounting. We also possess jurisdiction under 28 U.S.C. § 1292(a)(1), for the district court below, in effect, denied an injunction against further infringement.

12. 362 F.2d 660 (3d Cir. 1966).

13. *Id.* at 667 *quoting* Jenkins v. United States, 307 F.2d 637, 643 (U.S. App. D.C. 1962), in turn *quoting* McCormick, Evidence § 13 (1954).

within the discretion of the trial court.[14] The Supreme Court has posited that "the trial judge has broad discretion in the matter of the admission or exclusion of expert evidence, and his action is to be sustained unless manifestly erroneous."[15] It follows that this Court will not interfere with the decision of the trial judge as to an expert, absent an abuse of discretion.

In considering whether the trial judge should have recognized Mr. Lyle as an expert in this litigation, we must first determine which art is the pertinent one. Universal asserts that the relevant art is weight-training, whereas the defendants and the district court selected mechanical engineering. We doubt whether any mechanical engineer could provide meaningful opinions regarding the devices at issue here. For an engineer to assist the trial judge in his search for truth would require that he have at least some familiarity with body-building machines. At the same time, a mere weight lifter probably would be of marginal assistance to a court in evaluating the design facets of exercise apparatus. Consequently, the art germane to the present case is the design of body-training devices.

Having selected the relevant art, we may consider whether Mr. Lyle possessed the qualifications to be an expert in this case. It is apparent that he had little familiarity with the design of weight-lifting machines prior to the present litigation. The record reveals that Mr. Lyle did not undertake, even in connection with this law suit, any extensive study of technical references with respect to body-exercising apparatus. His examination was confined to the elements of prior art selected by defendants' counsel, *i.e.*, the Simmons patent and the Loprinzi photograph. As a result, it is doubtful whether he was suited to serve as an expert here.

14. *See, e.g.*, Salem v. United States Lines Co., 370 U.S. 31, 35, *reh. denied* 370 U.S. 965 (1962); United States v. 60.14 Acres of Land, 362 F.2d 660, 663 (3d Cir. 1966); Arnold v. Loose, 352 F.2d 959 (3d Cir. 1965).

15. Salem v. United States Lines Co., 370 U.S. 31, 35 (1962).

Even assuming that the disciplines designated by the parties were the apposite ones, Mr. Lyle's standing as an expert in this litigation still may be called into question. He had no expertise whatsoever in weight training, as he repeatedly conceded during the course of his testimony.[16] It is also questionable whether Mr. Lyle possessed any skill or knowledge in the field of mechanical engineering. A recipient of a bachelor's degree in *electrical* engineering, he had served for seven years as an examiner in the United States Patent Office and for thirty-five years as a patent attorney for Westinghouse. Although he did handle patent matters relating to turbines, motors and generators, which have mechanical facets, his patent work primarily pertained to electrical engineering. Experience may vest one with the qualifications of an expert,[17] but Mr. Lyle had only a limited background even in the province of mechanical engineering.

However, since Mr. Lyle may possess skill and knowledge greater than the average layman with respect to mechanical apparatus, we cannot find that the district court clearly abused its discretion in recognizing him as an expert. Nevertheless, coupled with the arguable deficiencies in his qualifications as an expert witness, Mr. Lyle's limited experience with the class of devices present in this litigation should have substantially circumscribed the weight accorded his testimony. The trial court thus erred in attaching controlling weight to the opinions of defendants' expert.

B.

Universal also challenges the expert testimony of Mr. Lyle, citing the conflict between his association with defense counsel and his role as an expert witness. Over the

16. *See, e.g.*, Appendix at 327, 394-95 (Trial Transcript at 458, 211, 632).

17. *See, e.g.*, United States v. 60.14 Acres of Land, 362 F.2d 660, 667 (3d Cir. 1966).

objection of Universal, the district court permitted Mr. Lyle to testify as an expert.[18]

Ordinarily it is inappropriate for an attorney, or a lawyer in his firm, to testify on behalf of a client. Rules DR5-101 and 102 of the Code of Professional Responsibility[19] provide that a lawyer shall refuse employment or withdraw as counsel if the "lawyer learns or it is obvious that he or a lawyer in his firm ought to be called as a witness on behalf of his client . . . ." Under such circumstances, the attorney, or his firm, must decide whether to serve either as an advocate or as a witness in a particular case. Recognizing that "the role of an advocate and of a witness are inconsistent . . . ,"[20] the Code would appear to preclude the testimony of Mr. Lyle here. As the disciplinary rules logically apply to expert as well as lay witnesses, the law firm should have withdrawn once it decided that its associate would testify, or else the firm should have found another expert.[21]

18. *See* Appendix at 273-79 (Trial Transcript at 376-382).

19. The Code of Professional Responsibility was promulgated by the American Bar Association in 1970. The Pennsylvania Supreme Court adopted the Code in 1974 for members of the Pennsylvania bar, among whose ranks are Mr. Lyle and defendants' attorneys. *See* Pennsylvania Rules of Court 1975 at 175-241. By contrast, neither the District Court for the Western District of Pennsylvania, which tried the present case, nor this Court has explicitly adopted the Code.

Although the Code does not have the force or effect of a statute, it delineates the basic norms of professional conduct, and courts generally have considered the Code as highly persuasive in disciplinary matters. *See, e.g.,* Handelman v. Weiss, 368 F. Supp. 258, 261 n.4 (S.D. N.Y. 1973); Estates Theatres, Inc. v. Columbia Pictures Indus., Inc., 345 F. Supp. 93, 95 n.1 (S.D. N.Y. 1972); E. F. Hutton & Company v. Brown, 305 F. Supp. 371, 377 n.7 (S.D. Tex. 1969).

20. EC 5-9.

21. The defendants contend that DR5-101 and 102 do not reach the testimony of Mr. Lyle. An exception to these rules allows a lawyer-witness to continue the representation of his client: "As to any matter, if [withdrawal] would work a substantial hardship on the client because of the distinctive value of the lawyer or his firm as counsel in a particular case." DR5-101 (B)(4). Defense counsel asserted at trial that this exception permitted the firm to continue its representation of the defendants, even if Mr. Lyle testified as an expert. The law firm contended, and the district court agreed, that withdrawal would cause "substantial hardship" for their clients, as the firm had spent great time and resources in preparing for the case.

Because the action was tried below without a jury, the trial judge could have adjourned the proceedings, without prejudice to the parties or a waste of court resources, until defendants selected another expert or, if they still

Even though the Code inveighs against the participation of Mr. Lyle as a witness, it does not necessarily follow that any alleged professional misconduct on his part would in itself render his testimony, once it was adduced, a nullity. This is so because the Code does not delineate rules of evidence but only strictures on attorney conduct. Moreover, it is well settled that a lawyer is competent to testify on behalf of his client.[22] Of course, such testimony may subject the attorney to separate disciplinary action. Thus, while we do not approve of the practice of an attorney testifying as an expert witness for a client of his law firm, and certainly in the absence of some necessity for such testimony, we cannot say that the district court committed error solely by not extirpating that

21. (Cont'd.)
desired the testimony of Mr. Lyle, another law firm. There is nothing in the record which indicates that the law firm with which Mr. Lyle was associated had such distinctive value in this litigation as to call DR5-101(b)(4) into play.

Nevertheless, we do recognize that DR5-101 and 102 are somewhat ambiguous as to whether these disciplinary rules apply literally to Mr. Lyle and his law firm DR5-101 and 102 require the withdrawal of an attorney from the conduct of a trial if he or another lawyer in the firm *"ought"* to be called as a witness on behalf of his client. Such language suggests that these sections of the Code were concerned only with the lawyer-witness who has crucial information in his possession which must be divulged. Under this test, Mr. Lyle hardly may be characterized as a witness who "ought" to testify on behalf of his firm's client. Defense counsel could have called any number of other experts to the stand. There is no suggestion in the record, nor could there be, that Mr. Lyle alone possessed the expertise necessary to assist the trier of fact. Because the defendants' expert was not an indispensable witness, arguably his testimony at trial did not breach the mandate of the Code.

22. *See, e.g.,* City Bank of Honolulu v. Rivera Davila, 438 F.2d 1367, 1369 (1st Cir. 1971); United States v. Harry Barfield Company, 359 F.2d 120, 124 (5th Cir. 1966); United Parts Mfg. Co. v. Lee Motor Products, Inc., 266 F.2d 20, 24 (6th Cir. 1959); Lau Ah Yew v. Dulles, 257 F.2d 744, 746 (9th Cir. 1958). While three of these cases were decided before the promulgation of the Code of Professional Responsibility, Canon 19 of the predecessor Canons of Ethics was roughly identical to DR5-101 and 102. Consequently, the principles enunciated in the pre-Code cases would appear to retain vitality.

Naturally, the statement in the text does not apply where the client invokes the attorney-client privilege, a long-standing rule of evidence. A client may refuse to disclose, and prevent his lawyer from disclosing, confidential communications between the attorney and his client. See 8 Wigmore on Evidence, §§ 2290-2329. (McNaughton rev. 1961). Generally, invocation of the privilege results in the exclusion of the attorney's testimony. The attorney-client privilege even embraces a lawyer not presently in the employ of the client, so long as he was the client's lawyer at the time of the privileged communication. *See* Wigmore, *supra,* § 2323. In the case at bar, the attorney-client privilege obviously was not claimed, and so Mr. Lyle's testimony is not incompetent.

testimony. In so concluding, we are in accord with the courts of appeals in several other circuits.[23]

In the case at hand, however, the district court did err when it relied so heavily on the testimony of Mr. Lyle. In Lau Ah Yew v. Dulles,[24] the Ninth Circuit, after criticizing the practice of an attorney testifying as a lay witness for his client, declared that testimony competent. But the court noted that the relationship of such a witness to his client detrimentally affected the weight to be accorded his testimony and therefore "discounted" its value.[25] Such an approach, which would appear to be equally applicable to attorneys who serve as experts for their clients, also reflects our view. We believe that, while a district court may in limited circumstances receive the testimony of a lawyer-witness, the value of that testimony must be discounted because of the interest of the lawyer or his firm in the outcome of the litigation.

Here, there is little indication that the district judge, as the sole trier of fact, scrutinized the expert testimony of Mr. Lyle with the proper circumspection.[26] It is one thing for a trial court to give the testimony of an interested witness some weight in reaching a decision. But it is quite another to permit the presumption of patent validity to be rebutted by primary reliance on the testimony of that witness. Even if, in the context of this case, it was not error to permit Mr. Lyle to testify, we conclude that the

23. See cases cited in note 22 *supra*.

It would be appropriate to consider incorporating within the body of evidentiary rules the current disciplinary norm proscribing the testimony of a lawyer for his client. The recently promulgated Federal Rules of Evidence, however, do not render such testimony incompetent. Nor is there any judicial precedent, insofar as we are aware, to support announcement of such a rule at this time.

24. 257 F.2d 744 (9th Cir. 1958).

25. *See id.* at 746-47.

26. When he refused to disqualify Mr. Lyle as an expert witness, the trial judge did state: "We will permit the witness to testify, but as to what effect this has upon his credibility, that will be up to the court . . . ." Appendix at 278-79 (Trial Transcript at 381-82). Nevertheless, there is no subsequent suggestion in the record that the district court evaluated Mr. Lyle's testimony with the requisite special care.

district court erred when it placed controlling weight, as to patent validity, on the opinions of a lawyer associated with defense counsel.[27]

III.

Because the district court gave undue weight to the testimony of Mr. Lyle, we must consider whether the remaining evidence in the record is sufficient to sustain the ruling that the patent claims are invalid.

It is a fundamental canon governing judicial consideration of patent validity that a presumption of validity attaches to patents issued by the United States Patent Office.[28] Not only has a unanimous Supreme Court noted that "patentees are heavily favored as a class of litigants by the patent statute,"[29] but we have stated on several occasions that the burden of proving patent invalidity is a heavy one.[30] Moreover, such invalidity must be demonstrated by "clear and convincing proof."[31] In the case at

27. In so holding, we express considerable doubt that the heavy presumption of patent validity can be overcome by the testimony of an attorney on behalf of his client. For a discussion of the presumption, see Part III *infra*.

28. 35 U.S.C. § 282 provides, in pertinent part: "A patent shall be presumed valid. . . . The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it."

Where the Patent Office specifically has considered references of prior art invoked by a defendant to invalidate a patent, the presumption of validity often is further reinforced. *See, e.g.*, Ellipse Corp. v. Ford Motor Co., 452 F.2d 163, 170 n.6 (7th Cir. 1971), *cert. denied*, 406 U.S. 948 (1972); Woodstream Corporation v. Herter's, Inc., 446 F.2d 1143, 1156 (8th Cir. 1971); Tapco Products Co. v. Van Mark Products Corp., 446 F.2d 420, 426 (6th Cir.), *cert. denied* 404 U.S. 986 (1971); *cf.* Philips Electronic and Pharmaceutical Industries Corp. v. Thermal and Electronics Industries, Inc., 450 F.2d 1164 (3d Cir. 1971). In the case at hand, the Patent Office specifically considered the Simmons patent, as Mr. Lyle noted in his testimony. *See* Appendix at 368 (Trial Transcript at 564). The defendants' expert also stated that the examiner had made a "good search." The precision exhibited by the Patent Office reinforces the presumption of validity accorded the Zinkin claims.

29. Blonder-Tongue Laboratories v. University of Illinois Foundation, 402 U.S. 313, 335 (1971).

30. *E.g.*, Trio Process Corporation v. L. Goldstein's Sons, Inc., 461 F.2d 66, 70 (3d Cir.), *cert. denied* 409 U.S. 997 (1972); Eagle Iron Works v. McLanahan Corporation, 429 F.2d 1375, 1382 (3d Cir. 1970); Schmidinger v. Welsh, 383 F.2d 455, 462 n.10 (3d Cir. 1967), *cert. denied*, 390 U.S. 946 (1968).

31. Trio Process Corporation v. L. Goldstein's Sons, Inc., 461 F.2d 66, 70 (3d Cir. 1972). *Cf.* Woodstream Corporation v. Herter's, Inc., 446 F.2d 1143, 1149 n.4 (1971).

bar, the evidence as to invalidity, once the testimony of Mr. Lyle is discounted, consists of only two items—the Simmons patent and the magazine photograph of Loprinzi's "super-duper pressing apparatus." This evidence in itself is not adequate to rebut the presumptive validity of the Zinkin patent, or to sustain the lower court's rulings as to obviousness and anticipation.

A.

We now turn to the ruling of the district court on the issue of obviousness. Although the trial judge invoked the proper authorities and standards in his consideration of this question, we believe that he erred in applying them to the Zinkin claims.

Inasmuch as this Court has adumbrated the precepts of obviousness on previous occasions,[32] we need not do so here. Instead, we enunciate only the analytical framework necessary for this case. Simply stated, a patent may be deemed invalid if it is "obvious." 35 U.S.C. § 103 provides, in part: "A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

As observed in Trio Process Corporation v. L. Goldstein's Sons, Inc.,[33] the most authoritative construction of section 103 appears in Graham v. John Deere Co.[34] There the Supreme Court established three mandatory criteria with which to frame judicial determinations as to obvi-

32. *See, e.g.*, Trio Process Corporation v. L. Goldstein's Sons, Inc., 461 F.2d 66, 70-73 (3d Cir. 1972); Philips Electronic and Pharmaceutical Industries Corp. v. Thermal and Electronics Industries, Inc., 450 F.2d 1164, 1172-75 (3d Cir. 1971); Eagle Iron Works v. McLanahan Corporation, 429 F.2d 1375, 1377-79 (3d Cir. 1970).

33. 461 F.2d at 70.

34. 383 U.S. 1 (1966). *See also* United States v. Adams, 383 U.S. 39 (1966).

ousness: "The scope and content of the prior art . . .; differences between prior art and the claims at issue . . .; and the level of ordinary skill in the pertinent art . . . ."[35] The Supreme Court also set forth several permissive, or "secondary," considerations: "commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."[36] This past term the Supreme Court continued to apply these criteria, thereby indicating the enduring vitality of *Graham*.[37] While the district court, in the present case, specifically considered the three mandatory tests, it erred in its evaluations under these tests, largely because of the dearth of evidence submitted by the defendants.

In analyzing the "scope and content" of the prior art, the trial judge indicated that the only relevant references offered by the defendants were the Simmons patent and the Loprinzi photograph. He properly disregarded exercising machines designed subsequent to the Zinkin patent. Although his opinion does not explicitly discuss the scope of the prior art, the fact that there were only two references suggests that the scope of the prior art is quite limited.

The trial judge did attempt to examine the content of the Simmons patent and the Loprinzi photograph. It is evident that he relied considerably upon the testimony of Mr. Lyle in analyzing the latter. As Mr. Lyle's testimony must be discounted, the district court would be hard pressed to evaluate the photograph. Even with Mr. Lyle's assistance, the trial judge appeared to be troubled about the features of the Loprinzi device. Indeed, his opinion

35. 383 U.S. at 17. Subsequently, the Supreme Court, in referring to these tests, "admonished that 'strict observance' of those requirements is necessary." Anderson's Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 62 (1969).

36. 383 U.S. at 17-18.

37. *See* Sakraida v. Ag Pro, Inc., U.S. , 47 L.Ed.2d 784 (1976); Dann v. Johnston, U.S. , 47 L.Ed.2d 692 (1976).

reflects uncertainty concerning that apparatus.[38] While the Simmons patent may have been more easily examined, since the defendants did produce detailed patent specifications, there were unanswered questions regarding its content as well. For example, it is unclear whether the described apparatus could be used for the chest-press exercise. In the absence of expert testimony, other than that of Mr. Lyle, the trial judge could not properly appraise the prior art, narrow in scope as it was. Although there may be instances where a trial court may be able to review prior art references without expert assistance, the devices in this litigation do not lend themselves to such evaluation.[39]

The district court also found that the differences between the prior art and the claims at issue were such that the invention is obvious. Nevertheless, because the defendants did not convincingly demonstrate the content of the prior art, we believe that it would be difficult for any court to evaluate differences between that prior art and the challenged claims. Even if it would be possible to do so, there is little evidence to support the conclusion that any variances between defendants' references and the Zinkin claims are "insignificant."

38. *See* 397 F. Supp. at 1069. The trial judge, in discussing the Loprinzi apparatus, stated: "From looking at the picture, it is not clear in what direction the levers can be moved, but the caption 'super-duper pressing apparatus' would clearly indicate to one familiar with weight-training that the movement is vertical. It also appears that each level is moved independently of the other, but that, too, is not certain from the picture and caption."

39. Ordinarily, the trial judge decides whether he needs expert assistance to understand or evaluate a reference relied on as prior art. Experts are not absolutely required, and a district court may disregard the testimony of experts if that testimony appears unreasonable. *See* Deller's Walker on Patents § 231 (2d ed. 1965) and cases cited therein. Nevertheless, in cases involving complicated inventions, the better rule is that the judge should rely on expert testimony. In Nyssonen v. Bendix, 342 F.2d 531 (1st Cir. 1965), for example, the First Circuit stated: "a patent speaks to its art and what it says can be told in complicated cases like this only by one skilled in the art." *Id.* at 537. Not only are the devices in this litigation somewhat intricate, but the evidence pertaining to them is unclear. We believe that the trial judge should have required the testimony of one skilled in the design of weight-lifting machines before invalidating the Zinkin claims. Even if defendants had produced such an expert, it still is questionable whether the factual proof submitted in this case was sufficient to void the patent.

We recognize that there *may* be some important differences between the prior art and the Zinkin claims. It is questionable, for example, whether either the Simmons patent or the Loprinzi apparatus obviates the spotter requirement of the chest-press exercise, as does the Zinkin device. The caption of the Loprinzi photograph depicts Sam Loprinzi "coaching a pupil in the use of [the] super-duper pressing apparatus." Arguably, Mr. Loprinzi is acting as a spotter as well as a coach in the picture, just as Harold Zinkin performed both roles in his gymnasium before designing his machine. Moreover, it is unclear whether the Simmons and Loprinzi devices circumvent, as does the Zinkin apparatus, the safety hazards posed by the chest press. Technically, there are various differences in design between the prior art and the challenged claims, involving, *inter alia,* the types of handles, the "stops," the requirement of a single bar and the positioning of numerous elements. While there is some doubt whether the differences between the referencs and the Zinkin claims are so substantial as to defeat the allegation of obviousness, we conclude that the evidence is insufficient to sustain the conclusion of the trial judge that all differences were such as to render the patented device obvious.

With respect to the third mandatory criteria under *Graham,* that is, the level of ordinary skill in the pertinent art, the district court acknowledged that "The record on this point is somewhat deficient."[40] Even so, the trial judge declared that "any competent mechanical engineer . . . could readily create a machine substantially the same as that of plaintiffs."[41] As discussed above, we believe that the pertinent art is neither weight-lifting nor mechanical engineering, but rather the design of body-exercising apparatus. Not only did the district court fail to select the proper art, but it is questionable whether the evidence submitted by the defendants speaks to the level of ordi-

40. 397 F. Supp. at 1070.

41. *Id.*

nary skill in the design of weight-lifting devices. Assuming that mechanical engineering is the relevant art, we are skeptical whether Mr. Lyle, upon whose testimony the district court substantially relied, could provide meaningful opinions thereon, given his inexperience in mechanical engineering. The trial judge suggested that the record as to the level of ordinary skill in the pertinent art was "deficient." Having so indicated, he should have refused to invalidate the challenged patent claims as obvious.

This Court need not consider the permissive, or secondary, criteria mandated in *Graham* for determinations of obviousness. For we are convinced that the defendants failed to provide adequate evidence to justify invalidation of the Zinkin claims under section 103. Even if the permissive tests were applied, the commercial success of the Zinkin machine [42] would reinforce our conclusion, as would the "failure of others" to obviate the safety hazards and manpower requirements of the traditional chest press exercise.[43] Thus, we cannot say that the Zinkin claims are so obvious as to render them invalid.[44]

B.

Besides holding the Zinkin claims void for obviousness, the district court concluded that they were anticipated by prior art. 35 U.S.C. § 102 provides, in pertinent part: "A person shall be entitled to a patent unless—(a) the invention was . . . patented or described in a printed publication in this or a foreign country, before the invention thereof

42. 397 F. Supp. at 1066. While the district court expressly recognized the commercial success of the Zinkin chest press machine, it did not utilize this fact in its analysis of obviousness.

43. *See* note 4 *supra*.

44. Such a holding is not at all inconsistent with Philips Electronic and Pharmaceutical Industries Corp. v. Thermal and Electronics Industries, Inc., 450 F.2d 1164 (1971). There this Court declared that a trial judge's findings as to the *Graham* criteria are to be evaluated under the "clearly erroneous" standard of Fed. R. Civ. Pro. 52(a). In the case at bar, the requisite findings would appear to be clearly erroneous, as there is insufficient evidence to support them. Thus the district court's conclusion as to invalidity cannot stand.

by the applicant for patent . . . ." The defendants had contended, and the trial judge agreed, that both the Simmons patent and the Loprinzi photograph anticipated the Zinkin claims so as to render them nugatory under the statute. Since there is insufficient evidence to rebut the heavy presumption of patent validity, we do not sustain this conclusion of the district court.

In construing section 102, the trial judge apparently viewed the Loprinzi photograph as a "printed publication" which described the Zinkin invention. While neither this Court nor apparently any other tribunal has yet determined whether a photograph in itself constitutes a "printed publication," we believe that a photograph may so qualify for purposes of section 102.[45] In so stating, we reaffirm our pragmatic pronouncement in Philips Electronic and Pharmaceutical Industries Corp. v. Thermal and Electronics Industries, Inc.,[46] that " to restrict our interpretation of section 102(a)'s 'printed' publication requirement solely to the traditional printing press would ignore the realities of the scientific and technological period in which we live . . . ."[47] With a photograph, one conversant in a pertinent art could make or construct a purported invention without resorting either to the patent or to his own inventive skills. Under certain circumstances, then, a photograph may so anticipate a patent as to render it invalid.

The question remains, however, whether the photograph of Loprinzi's device anticipated those claims of the Zinkin patent that the defendants challenge. We hold that it does not. In *Philips* we specified the circumstances under which a prior publication could anticipate a patent:

45. Several courts have held that a *drawing* unaccompanied by verbal description may constitute a description in a printed publication within the meaning of section 102. *See*, e.g., Des Rosiers v. Ford Motor Co., 143 F.2d 907, 911-12 (1st Cir. 1944); In re Bager, 47 F.2d 951, 953 (C.C.P.A. 1931). A photograph may disclose an invention as well as, if not better than a drawing and, consequently, is a "printed publication" for purposes of the statute.

46. 450 F.2d 1164 (3d Cir. 1971).

47. *Id.* at 1170.

"For a prior publication to be sufficient to defeat a patent it must exhibit a substantial representation of the invention in such full, clear, and exact terms that one skilled in the art may make, construct and practice the invention without having to depend on either the patent or on his own inventive skills."[48]

In the discussion of obviousness in Part III-A, we observed that it would be difficult, if not impossible, to discern the content of the Loprinzi photograph. That observation is applicable here, for it would not be possible for a trial court to ascertain whether the photograph anticipates the Zinkin invention. The photographic representation of the Loprinzi "super-duper pressing apparatus" hardly is "full, clear, and exact." It is questionable whether one skilled in the design of weight-lifting apparatus could produce the Zinkin device, based on an examination of the Loprinzi photograph. Accordingly, the magazine photograph is insufficient to render the patent invalid on the ground of anticipation.

Nor can we hold that the Simmons patent anticipated the Zinkin weight-lifting machine. It is unclear whether the Simmons invention encompasses all or substantially all of the elements of the apparatus under scrutiny in this case. The evidence submitted does not reveal whether one skilled in the design of body-exercising devices, or even in mechanical engineering, could develop the Zinkin weight-lifting apparatus based on the Simmons patent or on his own skills. We conclude, therefore, that the defendants in the present case have failed to demonstrate invalidity of the challenged claims under section 102.

IV.

While the validity of the Zinkin patent is not completely free from doubt, we do not accept the decision

48. *Id.* at 1169. For similar statements of the "anticipation" standard, see Eames v. Andrews, 122 U.S. 40, 66 (1886); Seymour v. Osborne, 78 U.S. 516, 555 (1870); Rich Products Corporation v. Mitchell Foods, 357 F.2d 176, 180 (2d Cir.), *cert. denied* 385 U.S. 821 (1966); Application of LeGrice, 301 F.2d 929, 936 (C.C.P.A. 1962); Deller's Walker on Patents § 60 (2d ed. 1964).

reached by the district court. The district court erred in according substantial weight to the testimony of Mr. Lyle. Without such unjustified reliance on that testimony, the trial judge could not properly interpret the prior art. Because the evidence produced by the defendants simply is not sufficient to rebut the presumption of validity accorded patents, we must reverse the rulings of the district court as to obviousness and anticipation, and sustain claims numbered 3 and 4 of the Zinkin patent.

The judgment of the district court will be vacated and the cause remanded for proceedings consistent with this opinion.

A True Copy:

Teste:

Clerk of the United States Court of Appeals for the Third Circuit.

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Order Amending Slip Opinion

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

No. 76-1023

UNIVERSAL ATHLETIC SALES CO., a corporation,
Appellant

v.

AMERICAN GYM, RECREATIONAL & ATHLETIC EQUIPMENT
CORPORATION, INC., et al.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
WESTERN DISTRICT OF PENNSYLVANIA

C.A. No. 71-166

Argued September 9, 1976
Before: ADAMS, ROSENN and GARTH, Circuit Judges.

ORDER AMENDING SLIP OPINION

It is hereby ORDERED that the following corrections be made in the slip opinion filed on November 19, 1976:

Page 2, footnote 2:

Change the words "the amendment is, as of this time, unreported. For the amended opinion, see Appendix at 61-63." to read "the amended judgment is set forth at 97 F. Supp at 1074."

Page 6, footnote 11:

Change the entire footnote, as set forth in the slip opinion to read:

This Court has jurisdiction pursuant to 28 U.S.C. §1292(a)(1), for the district court below, in effect, denied an injunction against further infringement. It may be that we also possess jurisdiction pursuant to 28 U.S.C. §1292(a)(4), which authorizes an appeal from a district court judgment in a patent infringement action that is final except for an accounting. But see 9 J. MOORE'S FEDERAL PRACTICE ¶110.19 [4] (1975). Because we believe that these provisions constitute sufficient grounds for jurisdiction, we did not certify this case for appeal under 28 U.S.C. §1292(b), as desired by the district court. See 397 F. Supp. at 1074. Absent these sources of jurisdiction, however, we would have issued the requisite §1292(b) certificate because this case raises substantial issues, the resolution of which should materially enhance resolution of this protracted litigation.

Page 9, footnote 19:

Change the entire first full paragraph of footnote 19, as set forth in the slip opinion, to read:

> The Code of Professional Responsibility was promulgated by the American Bar Association in 1969, and it became effective in 1970. The Pennsylvania Supreme Court explicitly adopted the Code in 1974 for members of the Pennsylvania bar, among whose ranks are Mr. Lyle and defendants' attorneys. See Pennsylvania Rules of Court 1975 at 175-241. However, it is apparent that the Code was applicable in Pennsylvania prior to 1974. See In re Estate of Lohm, 440 Pa. 268, 278-79, 269 A.2d 451, 457 (1970); Rules of Court, 331 Pa. xxxvi (1938). By contrast, neither the District Court for the Western District of Pennsylvania, which tried the present case, nor this Court has expressly adopted the Code.

By THE COURT,

Arlin M. Adams
Circuit Judge

Dated: December 30, 1976

Amended Judgment

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

No. 76-1023

UNIVERSAL ATHLETIC SALES CO., a corporation,
Appellant

v.

AMERICAN GYM, RECREATIONAL & ATHLETIC EQUIPMENT CORPORATION, INC., GRAYSON INDUSTRIES CORP., AMERICAN SUPER GYM CORP. and SUPER ATHLETICS CORPORATION, all corporations; RONALD ARBASEK, an individual; and LARRY SALKELD, DONALD E. PINCHOCK and S. DAVID BRODSKY, individuals, dba SUPER ATHLETICS CORPORATION

(D.C. Civil Action No. 71-166)

ON APPEAL FROM THE UNITED STATES
DISTRICT COURT FOR THE WESTERN DISTRICT
OF PENNSYLVANIA

Present: Adams, Rosenn and Garth, Circuit Judges

AMENDED JUDGMENT

This cause came on to be heard on the record from the United States District Court for the Western District of Pennsylvania and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said

District Court, entered October 29, 1975, be, and the same is hereby vacated and the cause remanded for proceedings consistent with the opinion of this Court. Costs taxed in favor of appellant.

Attest:

THOMAS F. QUINN

Clerk

UNITED STATES COURT OF APPEALS
For The Third Circuit

[Caption Omitted]

SUR PETITION FOR REHEARING
EN BANC

Present: SEITZ, Chief Judge, VAN DUSEN, ALDISERT, ADAMS, GIBBONS, ROSENN, HUNTER, WEIS and GARTH, Circuit Judges.

The petition for rehearing filed by the defendant-appellees, and specifically joined by Donald E. Pinchock, in the above entitled case having been submitted to the judges who participated in the decision of this court and to all the other available circuit judges of the circuit in regular active service, and no judge who concurred in the decision having asked for rehearing, and a majority of the circuit judges of the circuit in regular active service not having voted for rehearing by the court in banc, the petition for rehearing is denied.

By the Court,

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Circuit Judge

Dated: DECEMBER 9, 1976

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

UNIVERSAL ATHLETIC SALES COMPANY	)	
	)	
V.	)	Civil Action
	)	No. 71-166
AMERICAN GYM, RECREATIONAL & ATHLETIC EQUIPMENT CORPORATION, INC., GRAYSON INDUSTRIES CORPORATION, AMERICAN SUPER GYM CORPORATION and SUPER ATHLETICS CORPORATION; RONALD ARBASEK, LARRY SALKELD, DONALD E. PINCHOCK and S. DAVID BRODSKY individuals doing business as SUPER ATHLETICS CORPORATION	)	

June 23, 1975

OPINION

KNOX, District Judge

In this civil action the court must determine the validity of United States Letters Patent No. 2,932,509, "Body Exercising Apparatus", issued to Harold Zinkin on April 12, 1960. This action is but a part of a larger litigation among these parties. Their lawsuits in this court involve questions of copyright infringement, unfair competition, patent

infringement, patent misuse, and antitrust violations.[1] The path of this litigation has been filled with detours: a motion to disqualify counsel, a motion for civil contempt, and of course, lengthy discovery with resistance from both sides. Zinkin's "Body Exercising Apparatus" has given exercise to lawyers and judges in a manner the inventor would never have imagined.

Pursuant to Rule 42(b) of the Federal Rules of Civil Procedure, the court severed for trial the issues of patent validity, patent infringement, and unfair competition by defendants, thereby saving for a later time, if necessary, the questions of patent misuse and antitrust violations by plaintiff. Separation of these issues for convenience, expedition and economy is within the court's discretion

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[1] The copyright action has been adjudicated and is reported at 340 FS 899 (W.D.Pa 1972) rev'd 511 F 2d 904 (3d cir 1975) in which the circuit held no infringement. Other opinions in this case appear at 53 FRD 583 (1971) (Motion to amend answer and file counterclaim); 357 FS 905 (1973) (Refusal to disqualify counsel); and 376 FS 514 (1974) (Finding of civil contempt) rev'd on other grounds 511 F 2d 904 (3d cir 1975).

and has been widely approved. See "Separate Trials in Patent-Antitrust and Patent-Unenforceability Litigation", John B. Pegram, 64 FRD 185 (1974). Because we have severed these issues, we reject at this time certain findings of fact proposed by the parties but limit our findings to matters actually litigated or to which both parties agree. The findings and conclusions of law appear in this opinion pursuant to Rule 52(a).

I. PATENT VALIDITY AND INFRINGEMENT

The Zinkin patent contains eight claims of invention. Of these, only claims under Numbers 3 and 4 are disputed in this case. The claims read as follows:

> "3. A body exercising apparatus comprising an elongated substantially horizontal table having a predetermined head end and a foot end, an elongated bar extended from the head end of the table in substantial alignment therewith and having an end adjacent to the table and an opposite end, means pivotally mounting the extended end of the bar for pivotal movement about a substantially horizontal axis transversely of the table and in spaced relation to the head end therof whereby elevational movement of the bar causes the end thereof adjacent to the table to describe an arc with its concave side disposed toward the table, a pair of handles aligned transversely of the table, means rigidly mounting the handles on the bar for integral pivotal movement therewith, stop means engageable with the bar limiting downward travel of the handles to positions in upwardly spaced relation to the table, and means connected to the bar resistive to upward pivotal movement thereof."

> "4. A body exercising apparatus comprising an elongated substantially horizontal table adapted to support a person in supine position thereon having a predetermined head end and foot end, a framework adjacent to the head end of the table, an elongated bar pivotally mounted in the framework in substantial alignment with the table for movement about a substantially horizontal axis transversely of the table in spaced relation to the head end thereof and said bar being extended toward the table, a pair of handles rigidly mounted on the bar and disposed on opposite sides of the head end of the table, said bar terminating short of the table and leaving the area above the head end thereof free from obstruction, adjustable weight means borne by the bar, and a stop mounted in the framework engageable with the bar limiting downward pivotal movement thereof to a position with the handles disposed at an elevation above the table."

In simple terms, the claims describe a machine for simulating the chest press exercise performed with a free barbell. If done with a barbell, the exerciser lies on his back on a table and raises the barbell, to which weights may be added, from a position where his hands are near his chest and the bar is approximately aligned with the nipples to a position where the arms are fully extended and the bar is aligned with the shoulders. The exerciser continues by raising and lowering the barbell as many times as he desires or is able. A "spotter" is generally required to handle the barbells before and after the exercise and to safeguard the exerciser should he tire.

Using the patented machine, the exerciser lies on his back on a table and pushes against handles. The handles are mounted horizontally and at right angles to the exerciser's body so that the exerciser's hands are approximately in the same position as they would be to perform a chest press with a barbell. When the exerciser pushes on the handles, they move through a shallow arc to a point approximately

the same as that of the final position in the chest press with a free barbell. The design of the machine prevents the handles or attached bar and weights from striking the exerciser should he tire and be unable to complete the lift. The handles cannot move laterally with respect to the exerciser.

The machine does not consist of complicated arrangements of motors, gears, pulleys, springs, or other mechanical apparatus. Essentially, the machine is a lever. One end of the lever is pivotally mounted to a solid frame. The other end has handles attached. Weights are mounted to the lever to provide resistance, and provision is made so that the amount of resistance can readily be changed.[2]

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[2]The Zinkin patent shows weights stacked on a pin above the lever. The machines actually manufactured and sold by both the plaintiff and the defendant have weights suspended below the lever. The amount of resistance is changed by simply moving the selector key, and the weight stack itself serves as the "stop means" to prevent the lever from striking the exerciser. The plaintiff admits that the use of a selector key is quite old and does not claim invention in its use, but characterizes its use as the "essential equivalent of the patent". Trans. p. 27.

There is no question raised in this case as to the utility of the patented device. The utility of the chest press machine is apparent by its commercial success, by its safety advantage over the free barbell (the weights cannot fall on the exerciser), by the elimination of a spotter, and by the fact that the exerciser need not balance the resistance against lateral movement.

The defendants attack the Zinkin patent as lacking in novelty and being, at best, an obvious improvement on prior art. In statutory terms, their objections are embodied in 35 U.S.C.A. 102, 103.[3] After careful consideration, the court concludes that the Zinkin patent is void for obviousness and lack of novelty and invention.

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[3] §102. Conditions for patentability; novelty and loss of right to patent
A person shall be entitled to a patent unless --
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(cont'd)

We must begin with the proposition that a patent is presumed to be valid and that the burden of proof is on the party asserting invalidity. 35 U.S.C. 282. As noted in Trio Process Corp. v. L. Goldstein's Sons, Inc., 461 F 2d 66 (3d cir 1972), cert den 409 US 997, the burden of proof is a heavy one and invalidity must be demonstrated by clear and convincing proof.

The Supreme Court has set forth the criteria for determining the question of obviousness in Graham v. John Deere Co., 383 US 1, 15 L Ed 2d 545, 86 S Ct 684 (1966):

Footnote #3 cont'd:

* * *

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent.

§103. Conditions for patentability; non-obvious subject matter
A patent may not be obtained though the invention is not identically disclosed or described as set forth in §102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 19, 1953, c. 950, §1, 66 Stat 797-798.

> "[T]he scope and content of the prior art . . . , differences between the prior art and the claims at issue . . . ; and the level of ordinary skill in the pertinent art . . . . Such secondary considerations as commercial success, long felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."
> 383 US at 17, 15L Ed 2d at 556, 86 S Ct at 694.

The Supreme Court recognized in John Deere that §103 was, for the first time, a statutory expression of the additional requirement of patentability originally expressed in Hotchkiss v. Greenwood, 11 How. 248, 13 L Ed 683 (1850). While the court noted that §103 abolished the controversial phrase "flash of creative genius" used in Cuno Corp. v. Automatic Devices Corp. 314 US 84, 86 L Ed 58, 62 S Ct 37 (1941), and that the section focuses on the term "non-obvious" rather than on the "invention" language of Hotchkiss, the court held:

> "Although we conclude here that the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the

> requirements of §103, it bears repeating that we find no change in the general strictness with which the overall test is to be applied." 383 US at 19, 15 L Ed 2d at 557.

The overall test referred to is indeed a rigorous one, and no better expression of this can be found than in the famous "A & P" case [Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 US 147, 95 L Ed 162, 71 S Ct 127 (1950)] in which the court held invalid a patent for the invention of "a cashier's counter equipped with a three-sided frame, or rack, with no top or bottom, which, when pushed or pulled, will move groceries deposited within it". The court said:

> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained, when on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is

known into the field of its monopoly and diminishes the resources available to skillful men. This patentee has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly." 340 US 152-153, 95 L Ed at 167.

The court in John Deere also clearly delineated the requirements of patentability as follows:

"The Act sets out the conditions of patentability in three sections. An analysis of the structure of these sections indicates that patentability is dependent upon three explicit conditions: Novelty and utility as articulated and defined in §101 and §102, and nonobviousness, the new statutory formulation, as set out in §103."

Again, in Anderson's Black Rock v. Pavement Salvage Co., 396 US 57, 24 L Ed 2d 258, 90 S Ct 305 (1969), the court said:

"The patent standard is basically constitutional, Article I §8, of the Constitution authorizing Congress "[t]o promote the Progress of . . . useful Arts" by allowing inventors monopolies for limited times. We stated in Graham v. John Deere Co., 383 US 1, 6, 15 L Ed 2d 545, 550, 86 S Ct 684, that under that power Congress may not 'enlarge the patent monopoly without regard to the

innovation, advancement or social benefit gained thereby. Moreover, Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of . . . useful Arts'. This is the standard expressed in the Constitution and it may not be ignored.'"

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"We conclude that while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented. We conclude further that to those skilled in the art the use of old elements in combination was not an invention by the obvious-nonobvious standard. Use of the radiant-heat burner in this important field marked a successful venture. But as noted, more than that is needed for invention."

In determining the question of obviousness the court must consider all prior art whether or not the patentee knew of it. Layne-New York Co., Inc. v. Allied Asphalt Co., Inc., 501 F 2d 405 (3d cir 1974) cert den April 14, 1975; Arrow Safety Device

Co. v. Nassau Fastening Co., 496 F 2d 644 (3d cir 1974). The fact that significant prior art not considered by the Patent Office is brought forth weakens the patent's presumption of validity. Layne-New York, supra; U. S. Expansion Bolt Co. v. Jordan Industries, Inc. 488 F 2d 566 (3d cir 1973).

We are cautioned that the mere simplicity of the device, though it may suggest obviousness, is not by itself a reliable test of obviousness, as many things will seem obvious when viewed with the advantage of hindsight. See Price v. Lake Sales Supply R. M., Inc., 510 F 2d 388 at 393 (10th cir 1974). A device may of course, satisfy the requirement of Section 102 with a novel combination of old elements, yet fail to satisfy the Section 103 requirement of non-obviousness.

It is against this background that the court must determine the validity of Zinkin's patent. The defendants rely on the following in support of their claim of invalidity:

DX-3 (in part)

Patent No. 117,339, dated July 25, 1871, by C. A. Simmons for a "Lifting Machine". (Cited by Patent Office as prior art).

DX-7 and DX-17

Picture appearing in "Strength and Health" magazine, May-June, 1950, p. 50, showing exercise apparatus attributed to Sam Loprinzi and described in the accompanying text as "super-duper pressing apparatus". DX-17 is an artist's sketch of the apparatus shown in DX-7 (Not cited by Patent Office as prior art).

DX-15

Marcy's "New Mach 1" exercising machine, shown in Marcy catalogue of 1975.

DXE-35

Machine used by Pittsburgh Steeler Football team. Designed by Reicke.

We now discuss these materials under the primary criteria set forth in Graham. In our inquiry here we will disregard the Marcy and Reicke machines (DX-15 and DXE-35), as these were obviously designed subsequent to the Zinkin patent.

(A) The Scope and Content of the Prior Art

The Simmons patent shows an exercising machine patented in 1871. A framework consisting of three sets of parallel bars is pivoted on a stand. Each set of parallel bars has notches in which a cylindrical weight is placed, and the amount of resistance to be lifted is adjusted by placement of the weights in the various notches. The framework has handles with which the exerciser pivots the bar and weights. As the patent does not picture a table and since the specifications state: "I make two sets of handles at different heights for suiting the machine to short or tall people," it is apparent that the machine is used to perform lifts from a standing rather than a prone position.

The Loprinzi apparatus (DX-7 and 17) shows a pair of levers over a table. The levers have brackets for weights. From looking at the picture, it is not clear in what direction the levers can be moved, but the caption "super-duper pressing apparatus" would clearly indicate to one familiar with weight-training that the movement is vertical. It also

appears that each lever is moved independently of the other, but that, too, is not certain from the picture and caption. A picture of the Loprinzi apparatus appeared in a magazine of May-June, 1950.

(B) Difference Between the Prior Art and the Claims at Issue.

The Zinkin, Simmons and Loprinzi devices all operate on the same basic principle: weights attached to a lever are rotated about a pivot. The Simmons patent is designed, not for the chest press exercise, but for some other exercise performed in a standing position. However, we find this difference insignificant and find that it would be obvious to change the design to a higher or lower elevation so that the exerciser can perform different lifts. The addition of a table for this purpose is a trivial change. Likewise, we find that the handles on which the exerciser pushes or pulls are different on the three devices, but that this change, too, is obvious. The three devices, of course, are quite different in appearance, but as we have stated, their operating

principles are essentially the same. We find that the improvements made by Zinkin over prior art and cited by plaintiff as invention are no more significant than the change in the method of providing resistance between the commercially sold machines and the actual patent. This latter difference the plaintiffs consider insignificant and merely the "essential equivalent of the patent."[4]

(C) The Level of Ordinary Skill In The Pertinent Art.

The record on this point is somewhat deficient. The parties have addressed this question in terms of the knowledge and skill of persons in the weight-training industry, viz: persons who are quite familiar with exercises, muscular development, and weight-training equipment, but who have not been shown to have any particular skills in mechanical engineering. The record does, however, contain opinions by both parties' experts as to obviousness. The court chooses to adopt the view of defendant's expert Firman Lyle. We hold that in light of the ancient

[4]See Footnote #2

origin of the lever and the prior application of the lever in the Simmons and Loprinzi machines, the development of the Zinkin machine was well within the ordinary skill of one knowledgeable in the pertinent arts.

Of course, there is no suggestion in the above remarks that an improvement must be obvious merely because it was made by one without particular skills in the pertinent art or craft. But we do hold that this simplistic device in a crowded art is obvious and not patentable. Examination of the Zinkin machine leaves the court with the unshakable belief that any competent mechanical engineer, assigned to design a device for performing a chest press and informed of the prior art, could readily create a machine substantially the same as that of plaintiff's.

Our opinion does not change when we consider the patent as a whole, rather than as a combination of several small changes. The plaintiff has created a useful machine, but one with no surprise, the sum

of whose parts are no greater than its individual components. The Zinkin machine is one about which the Supreme Court might say, as it did in A & P, "Two and two have been added together, and still they make only four." 340 US at 152, 95 L Ed at 167.

The plaintiff has produced considerable expert testimony that the arcuate movement of the handles on the Zinkin machine is a better method of exercising than the straight-line up and down movement found in other chest press apparatus and in the free barbell chest press. The defendants have produced contrary expert opinion.

The plaintiff admits that Zinkin did not have that factor in mind when he designed the machine, but they cite it as an unexpected benefit still deserving of patent protection. We find the evidence of this supposed benefit unconvincing. While several witnesses indicated they felt the arcuate movement more natural and comfortable, others testified to the contrary. We find that either exercise is

equally beneficial. The preferences stated for one over the other have no more significance than the fact that some people like one lump of sugar in their coffee but others must have two. The amount of curvature through which the handles actually move in plaintiff's commercially sold machine is very small, and we find that the arcuate movement has no real significance. We are unable to find that such movement has any superiority in building muscles.

The court concludes that the Zinkin Patent is void as obvious within the meaning of 35 U.S.C. §103. For similar reasons, we also hold that the Zinkin patent is void for lack of novelty within the meaning of 35 U.S.C. §102, as it was anticipated by prior art. We are, of course, aware of the cases that state that anticipation means that every element of the claims is found in a single prior art reference, but we find that both the Simmons and Loprinzi devices satisfy this criterion. The differences in the Zinkin Patent from these prior art references,

such as the addition of a table and a different method of providing "stop means", are minor and do not make the doctrine of anticipation inapplicable.

In addition, we find that the defendant's chest press apparatus would infringe the Zinkin Patent if the Zinkin Patent were not void as obvious and lacking in novelty. While the question of infringement is, of course, rendered moot by our determination of patent invalidity, we make that finding at this time in the interest of judicial economy for whatever value it may have in the future of this ongoing litigation. We do not, however, by making this finding foreclose the question of patent misuse.

II. UNFAIR COMPETITION

The plaintiff asserts that the defendants have made various misrepresentations and have engaged in other unfair competitive practices in selling their "Super Gym", thereby making them liable to plaintiffs

under the common law and under Section 43(a) of the Lanham Act, 15 U.S.C. 1125(a). The alleged unfair competitive practices include false and misleading specifications in advertising brochures, false assertions that "Super Gym" and other trade names of the defendants are registered trademarks, the use of side-by-side comparison charts which allegedly misrepresent both plaintiff's and defendant's products, the use of "specious" guarantees that defendants could not financially undertake, misrepresentations about defendants' sales and financial condition, and the displaying of one of plaintiff's machines in a "dirty, corroded, broken and incomplete" condition.

The Lanham Act, 15 U.S.C. 1125(a)[5] provides a civil remedy by way of damages or injunction against anyone

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[5]"(a) Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce

who, in connection with goods or services in commerce, uses a false description of origin or any false description or representation. Parkway Baking Co. v. Freihofer Baking Co., 255 F 2d 641, 648 (3d cir 1958); L'Aiglon Apparel v. Lana Lobell, Inc., 214 F 2d 649 (3d cir 1954). Both of these cases recognize the Lanham Act as creating a new federal tort and indicate that as the Act is remedial statute, it should be broadly construed. While it is well established that the Act does not prohibit every kind of unfair competitive practice, such as misrepresentations about a competitor's product, Bernard Food Industries, Inc. v. Dietene Co., 415 F 2d 1279 (7th cir 1969) cert den 397 US 912, 25 L Ed 2d 92, 90 S Ct 911, some cases have indicated that the Act prohibits any misrepresentations about

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Footnote #5 cont'd:
or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation."

one's own products and is not limited to misrepresentations involving trademarks, designations of the origin of goods, and other attempts to "pass off" one's goods as those of another. Ames Publishing Co. v. Walker-Davis Publications, Inc., 372 FS 1 (E.D.Pa 1974).

Other circuits have indicated a more limited scope for the Lanham Act than has the Third Circuit. In Bernard Food, supra, the court says, quoting from Samson Crane Co. v. Union National Sales, Inc., 87 FS 218 (D. Mass. 1949) aff'd per curiam 180 F 2d 896 (1st cir 1950):

> It is true that the section speaks of 'any false description or representation' but this must first be interpreted in the light of the succeeding phrase which explains these words as including words or symbols tending falsely to describe or represent, not any fact, but the goods or services in connection with which the description or representation is used. The intent of Congress in passing the Act is set forth in the final paragraph of Section 1127. Only one phrase of that paragraph fails to use the word 'mark'. And that phrase ('to protect persons engaged in such commerce against unfair competition') must in such a context be

> construed to refer not to any competitive practice which in the broad meaning of the words might be called unfair, but to that 'unfair competition' which has been closely associated with the misuse of trademarks, i.e., the passing off of one's own goods as those of a competitor. It is clear, both from this statement of the intent and from a reading of the Act as a whole, that the primary purpose of the Act was to eliminate deceitful practices in interstate commerce involving the misuse of trademarks, but along with this it sought to eliminate other forms of misrepresentations which are of the same general character even though they do not involve any use of what can technically be called a trademark. The language of Section 43(a) is broad enough to include practices of this latter class. But the section should be construed to include only such false descriptions or representations as are of substantially the same economic nature as those which involve infringement or other <u>improper use of trademarks</u>. It should not be interpreted so as to bring within its scope any kind of undesirable business practice which involves deception, when such practices are outside the field of the trademark laws, and especially when such undesirable practices are already the subject of other Congressional legislation, such as the Federal Trade Commission Act. (Footnote omitted.)

The Third Circuit case of Parkway Baking, supra, involved the misuse of the designation "Hollywood Bread" on defendant's products thereby implying that

it was sold under the sponsorship or with the approval of the registered owner of the "Hollywood" trademark. L'Aiglon Apparel, supra, concerned the fraudulent and injurious use of a picture of plaintiff's $17.95 dress in advertising defendant's $6.95 dress. Both of these cases involve the "passing off" of goods within the ambit of Bernard Foods, supra, and do not actually involve misrepresentations of the kind found here. The court has some reservations as to whether the Third Circuit would today hold that the misrepresentations of this kind are actionable by a competitor under the Lanham Act. However, because of the broad language in L'Aiglon and Parkway Baking, and in light of the recent Eastern District of Pennsylvania case of Ames Publishing Company, supra, the court feels constrained to hold that the Lanham Act applies to misrepresentations of one's own goods, even where the misrepresentations do not tend to confuse one's goods with those of a competitor or otherwise misstate the origin of the goods or to pass the goods off under another's trademark.

The court has weighed the testimony of Larry Salkeld very carefully. During his early testimony, while he was President of Super Athletics Corporation, he was an uncooperative witness and even walked out of one deposition before it was completed. After he was fired by defendants, he became hostile toward them, and as we stated in Universal Athletic Sales Co. v. American Gym Co., et al, 357 FS 905 (1973), he had to some extent "sought shelter in the tents of the enemy".

In the light of this, the heavy reliance placed upon Salkeld's testimony by the plaintiff may be misplaced, but in view of many exhibits and the corroborating testimony of the other witnesses, we find that Salkeld's testimony is substantially true and that the practices complained of by plaintiff generally occurred.

The machines actually produced by the defendants generally failed to conform to the specifications

in the advertising brochures. It further appears, however, that defendants' orders were taken to some extent on a custom made basis, that is, the machines were made to meet the particular requests of individual purchasers. Further, many of the changes between the machines actually delivered and those advertised resulted from good faith attempts to improve the product, or because the specifications originally listed proved unworkable.

Most of plaintiff's claims are nonactionable under common law and under the Lanham Act. For example, failing to register a trade name can make it unenforceable, but plaintiff has shown the court no case law or statute that provides a competitor redress in damages for false representations that the trade name is registered. In any event, the court does not see how such misrepresentation injures a purchaser of the machine, or a competitor, where the competitor does not claim the trade name as its own.

Other alleged misrepresentations are not misrepresentations of present facts at all but are future promises. For example, defendant's guarantee, no matter how "specious", is simply a promise that should the product fail, Super Athletics would repair or replace it, according to the terms of the guarantee. Failure to honor the guarantee would give a cause of action to a purchaser, but not to a competitor not privy to the sale. In addition, there is no evidence that the defendants failed to honor their guarantees, in fact, the evidence shows the contrary.

Disparagement of a competitor's product is also not actionable under the Lanham Act. Bernard Foods, supra. Nor does the record contain sufficient evidence of common law disparagement of plaintiff's product to warrant relief on that basis. Every competitor in the market place is expected to sing a little of the tune "Anything Their's Can Do, Ours Can Do Better". See Ringling Brothers v. Chandras Am. Line, Inc., 321 FS 707 (S.D.N.Y. 1971)

The brochures and comparison charts used by defendants, however, contain a number of overstated or misleading descriptions of their product. While slight discrepancies would almost inevitably occur, we find that the consistent overstatement of the amount of resistance during the various exercises, and the general failure to give true resistance after adjusting for leverage effects, are material misrepresentations of a kind actionable under the Lanham Act in accordance with our previous discussion.

We further find that reliance by purchasers and damage to plaintiffs, who bid against defendants on numerous sales, have also been shown. We find this on the basis of Farrell's testimony as to the trade practices in the industry, Salkeld's testimony, and PTX-56, a letter of complaint that a machine received "hardly bears a resemblance to the ones shown me on my visits to the factory -- [n]or does it meet the specs. in the brochure."

Regardless of whether Salkeld's actions as President of Super Athletics Corporation would make

him and the corporation liable for unfair competition, we find no basis for imposing personal liability on defendants Brodsky and Pinchock. While these two were stockholders and officers of Super Athletics Corporation, it appears that Salkeld alone had the personal knowledge of the specifications on the brochures and comparison charts. While these defendants did on some occasions review the comparison charts and brochures with Salkeld to verify their accuracy, they relied considerably on his knowledge and expertise. We find that neither of these defendants personally mailed, or directed others to mail, advertising material with specifications they personally knew or should have known to be false.

We therefore will enter judgment for the plaintiff against the defendant Super Athletics Corporation and in favor of the defendants Pinchock and Brodsky against the plaintiff, on the Lanham Act claim. The appropriate damages to be recovered by plaintiff will be determined at a time to be hereafter fixed.

In view of our findings under the Lanham Act, we find it unnecessary at this time to determine whether common law unfair competition has been shown under the Restatement of Torts, Section 761, or otherwise. In view of the multistate sales occurring in this case, we decline to determine that issue in view of the limited briefing by the parties at this time.

Any judgment against Salkeld is entered at this time because default judgment was previously entered against him on April 22, 1974.

United States District Judge

CC:

Counsel of record.

IN THE
UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

UNIVERSAL ATHLETIC SALES CO.	)	
	)	
v.	)	Civil Action
	)	No. 71-166
AMERICAN GYM, RECREATIONAL AND ATHLETIC EQUIPMENT CORPORATION, et al.	)	

Dated: October 29, 1975.

MEMORANDUM AND ORDER

RE: PLAINTIFF'S MOTION TO ALTER AND AMEND JUDGMENT

Plaintiff has filed a motion under Rule 59 to alter or amend the judgment entered June 23, 1975, in this case with respect to Zinkin Patent No. 2,932,509. The motion has been argued and briefed and the court will in this memorandum dispose of the points raised.

As to plaintiff's claim that the court's judgment is overly broad in declaring Patent No. 2,932,509 invalid in toto, while in fact only Claims No. 3 and 4 of the patent have actually been litigated, the court finds that the plaintiff's position is well taken. Section 181 of Title 35 U.S.C., Patents, provides:

"PRESUMPTION OF VALIDITY - DEFENSES

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of the other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it."

This case has proceeded on the basis that only Claims No. 3 and 4 were disputed. As the other six claims of the patent have not been contested in this action, the presumption that they are valid would certainly preclude a contrary finding by the court in the absence of any evidence. Although these claims are of record (Plaintiff's Ex. 79 shows the entire patent), they have not been the subject of expert testimony or argument of counsel. These six claims do appear to be of a similar nature to claims 3 and 4, and it may be that they should logically stand or fall with those claims. However, despite defendant's argument that the public would best be protected by declaring the entire patent invalid, the court knows of no basis for so doing. In any event, a judgment invalidating these six claims, if relied upon by some other party for collateral estoppel, might fail to withstand a Blonder-Tongue[1] attack as being entered without a full and fair opportunity to litigate.

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1. Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 US 313, 28 L Ed 2d 788, 91 S Ct 1434 (1971).

A defendant is, of course, protected from repeated litigation--first under one claim of a patent and then under another--by the principles of laches and of collateral estoppel. Likewise, an alleged infringer might counterclaim for a declaratory judgment, bringing into direct issue those other claims of invention the defendant fears might subsequently be asserted against it. The judgment will be amended accordingly.

The plaintiff's remaining exceptions will be denied. Many of these raise purely semantical differences. For example, plaintiff excepts to the entry of judgment for the defendants "with respect to the issues of patent validity and infringement". It is true that the court found, as plaintiff asserts, that infringement would have occurred if the patent were valid, but having held the patent invalid, the court must necessarily enter judgment for the defendants on that claim of relief. Plaintiff's formulation of judgment for the defendants "with respect to the issue of patent validity and the claim of infringement" is equally ambiguous; it might suggest to the reader that plaintiff's claim was not sustained because no infringement was found, rather than because the patent is invalid. In either case, one must look to the opinion to find the basis for the judgment.

The court also finds it inappropriate to make the further findings of fact requested by plaintiff. While some of these matters are not seriously disputed, such as the witness Firman Lyle's association with defense counsel's firm, the court did not in its opinion state many matters that pertain to the credibility of witnesses or the details of their testimony all of which were considered in arriving at the conclusions of the court. The court believes the opinion amply states the reasons for holding.

The motion to alter and amend judgment will therefore be denied except as indicated above. An appropriate order will be entered.

WILLIAM W. KNOX

United States District Judge

CC:
Counsel of record

IN THE
UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

UNIVERSAL ATHLETIC SALES CO.	)	
	)	Civil
v.	)	Action
	)	No. 71-166
AMERICAN GYM, RECREATIONAL AND ATHLETIC EQUIPMENT CORPORATION, et al.	)	

AMENDED JUDGMENT ORDER

AND NOW, to wit, October 29, 1975, the judgment order entered June 23, 1975, is hereby amended as follows:

IT IS ORDERED that claim Nos. 3 and 4 of Patent No. 2,932,509 issued to Harold Zinkin on April 12, 1960, are hereby adjudged and declared to be invalid;

IT IS FURTHER ORDERED that as to the remaining claims of the patent the judgment entered June 23, 1975, is vacated, no determination being made as to the validity of those claims.

IT IS FURTHER ORDERED that plaintiff's motion to alter and amend judgment is otherwise denied and the judgment entered in this case on June 23, 1975, is reaffirmed except as expressly amended and altered in this order.

WILLIAM W. KNOX
United States District Judge

CC:
Robert Yeager, Esq.
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FIRMAN P. LYLE

was called as a witness by the defendants, was duly sworn, and testified as follows:

MR. DALGARN: Your Honor, may we ask that this witness is being called as the expert as indicated in the defendant's pretrial narrative statement?

MR. MURRAY: This is the Firman Lyle I listed in the pretrial statement, yes.

MR. DALGARN: Your Honor, we will have to object to any testimony by the witness in this case on two grounds, the first being that PTX-95 was a set of interrogatories served upon the defendants in this case which essentially asks them to state each person to be called as an expert witness; the subject matter on which they are expected to testify; each opinion that will be offered by them; the basis for each opinion, and the factual background.

With regard to those, we received as an answer to all of them, "Defendants have not as yet decided who will be called as expert witnesses, but will advise plaintiff as soon as this is determined."

We received no supplemental answers to those interrogatories, even though we requested Mr. Murray, as late as two weeks ago -- is that correct?

MR. YEAGER: Last week.

MR. DALGARN: Last week.

MR. MURRAY: Well, Your Honor, those interrogatories were served -- when were they served, Mr. Dalgarn?

MR. DALGARN: The 9th day of November, 1973.

MR. MURRAY: It is a year ago. Before our pretrial statement was filed, that was requested.

THE COURT: Weren't we over this before?

MR. DALGARN: I don't believe so.

MR. MURRAY: I don't think so.

MR. DALGARN: The second ground on which we would object, Your Honor, involves what we think is an ethical problem. The last time we raised an ethical problem in the case, it caused a lot of waste motions and time and effort by everybody with no particular results in our favor. But I think that this one bears some looking into by the Court.

Mr. Lyle has been identified as being associated with, and an employee of, the firm representing the defendants, the firm of Brown, Murray, Flick & Peckham.

MR. MURRAY: He is not an employee, Mr. Dalgarn.

THE COURT: Well, was this witness identified in your pretrial narrative?

MR. MURRAY: Yes.

THE COURT: I can't seem to lay my hands on it here.

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MR. MURRAY: As far as these interrogatories are concerned, Your Honor, they are answered by the pretrial statement itself. We did answer them initially when we didn't know, and what we didn't know, we put in our pretrial statement.

Now, Mr. Yeager did call me up last week and asked for formal answers. I did not serve those; I said I would, but I didn't serve formal answers sworn to. But they already had this information.

MR. DALGARN: Your Honor, we don't have the information asked for.

THE COURT: Does someone have a copy of the pretrial narrative statements? A copy seems to be missing.

MR. DALGARN: Your Honor, may I approach the bench?

(Handing.)

THE COURT: Well then, this witness was identified in the defendants' pretrial narrative statement which, apparently, was received by the plaintiffs on March 16, 1974, is that correct?

MR. DALGARN: Yes, Your Honor.

THE COURT: And there was a summary of his testimony.

MR. DALGARN: A brief summary of what he was going to testify to on the issues of infringement, and, I believe, review the file history of the patent.

THE COURT: That's right. Well then, it appears that takes care of any objection based on the fact they didn't identify it in the interrogatories, and you are supposed to make, perhaps, continuing current supplements.

MR. DALGARN: Excuse me, Your Honor, but the interrogatories go further than that. We wanted the subject matter as provided in the rules with regard to obtaining discovery on experts; we wanted the subject matter on which a person is expected to testify. That was broadly identified.

MR. MURRAY: You know that.

MR. DALGARN: Correct. But Interrogatory No. 5.3, which is cast in the terms of the Rule 26b(2), I believe, asks for the substance of the facts to which that person is expected to testify; the substance of the opinions to which that person is expected to testify, and the grounds for each opinion set forth in the answer to part b thereof.

Each one of those was answered with the same answer that was given on No. 5.1, which was an undertaking by the defendants to provide those answers as soon as they obtained the information and located their expert.

MR. MURRAY: Well, Your Honor, they know what this man is going to testify to from the pretrial statement. He is going to testify that there

is no infringement, and that the patent is invalid. I think that is perfectly obvious to anyone.

THE COURT: Well, as I recall, this is about as complete as the statement in your pretrial narrative, Mr. Dalgarn.

MR. DALGARN: Yes, Your Honor. Your Honor, they did not serve any interrogatories on us to ask what the opinions were that were going to be given. It is necessary, particularly when an expert is testifying, to have the basis of his opinions to be able to formulate effective cross examination.

THE COURT: Well, the rules of our court require that copies of the expert's report be attached to the pretrial narrative statement.

MR. DALGARN: Yes, Your Honor.

THE COURT: They were not attached to the plaintiff's statement, and they are not attached here. So, you are both in violation. So, I think it is --

MR. DALGARN: There were no reports to be given.

THE COURT: That doesn't make any difference. If you have a verbal report, you are

supposed to set that forth. It doesn't say written reports. We want written reports ordinarily, but if an expert won't give you a written report, he can tell us what he is going to tell you over the telephone.

I think this is a case of the pot calling the kettle black, and we will overrule the objection based on that.

Now, you say you have some ethical problems?

MR. DALGARN: Yes, Your Honor. We call attention to the Code of Professional Responsibility, Rules of Disciplinary Enforcement of the Pennsylvania Bar Association, specifically Rule DR 5-101, entitled, "Refusing Employment When the Interests of the Lawyer May Impair His Independent Professional Judgment."

"A lawyer shall not accept employment in contemplated or pending litigation if he knows or it is obvious that he or a lawyer in his firm ought to be called as a witness, except that he may undertake the employment and he or a lawyer of his firm may testify if the testimony will relate solely to an uncontested matter; if the testimony will relate solely to a matter of formality and there is no reason to believe that substantial evidence will be offered in opposition to

the testimony; if the testimony will relate solely to the nature and value of legal services rendered in the case by the lawyer or his firm to the client; No. 4, as to any matter, if refusal would work a substantial hardship on the client because of the distinctive value of the lawyer or his firm as counsel in the particular case."

MR. MURRAY: Your Honor, I don't see how that has any applicability to this whatever. Mr. Lyle has testifed in a case before Judge Webber; no objection was made. He is testifying here as an expert.

THE COURT: You say an objection was made?

MR. MURRAY: No objection was made.

THE COURT: Well, now, your pretrial narrative says, from '37 to '73, he was a patent attorney for Westinghouse Electric Corporation. At the present time he is associated with the firm of Brown, Murray, Flick & Peckham.

MR. MURRAY: That's correct.

THE COURT: Well, in what capacity is he associated with the firm?

MR. MURRAY: He is just an associate, Your Honor. He is not an employee. It is a percentage of his fees that he is paid.

THE COURT: Would you read DR 5-101 again, Mr. Dalgarn?

MR. DALGARN: I didn't finish reading, I think, which is more the important pertinent section.

THE COURT: All right.

MR. DALGARN: Your Honor, may I hand this up?

THE COURT: That is the lawyer himself testifying, or a member of his firm?

MR. DALGARN: Yes, Your Honor. I might read part A under that.

THE COURT: Yes.

MR. DALGARN: "If, after undertaking employment in contemplated or pending litigation, a lawyer learns or it is obvious that he or a lawyer in his firm ought to be called as a witness on behalf of his client, he shall withdraw from the conduct of the trial and his firm, if any, shall not continue rep-

resentation in the trial, except that he may continue the representation and he or a lawyer in his firm may testify in the circumstances enumerated in DR 5-101b(1) through (4)."

If I may, I would like to hand this document to Your Honor.

MR. MURRAY: Your Honor, it seems to me that that rule applies to a case where the lawyer is testifying as to facts; in other words, we have a situation wherefore someone in the firm gets into a lawsuit and then finds out his partner, or even an employee, has to testify as to expert facts. We don't have Mr. Lyle here to testify as to any facts. We could have gone out and gotten any one of a number of different patent attorneys to testify in this case.

THE COURT: I am reading the rule. It says, not a member of the firm, "he or a lawyer in his firm" -- I think it is broad enough to cover associates -- "is called as a witness."

MR. MURRAY: I might add, Your Honor, you know, this is the first time this has ever been brought up to me. We prepared -- Mr. Lyle, here, he spent a lot

of time. They have known that he was going to be called as a witness for at least nine months.

THE COURT: What I am looking at is Clause 5-101b(4).

Now, b starts out, "A lawyer shall not accept employment if he knows or it is obvious that he or a lawyer in his firm ought to be called as a witness, except that he may undertake the employment that he or a lawyer in the firm may testify, (1) -- these are the exceptions -- uncontested matters; matters of formalities with no substantial evidence; value of legal service; but, then, 4 reads: "That he or a lawyer in his firm may testify as to any matter if refusal would work a substantial hardship on the client because of the distinctive value of the lawyer or his firm as counsel in the particular case."

Now, we all know that Mr. Murray has been associated with this litigation from the start.

MR. DALGARN: Yes, Your Honor.

MR. MURRAY: And there was one other point, Your Honor.

MR. DALGARN: We do not seek the withdrawal of Mr. Murray. The only thing we are saying is that he had a choice of preparing any expert to testify on this thing outside of his firm. For a member of his firm to come in here and testify on the principal issues of this case becomes nothing more than an attempt to put into the record as testimony what are actually contentions of defendants' own counsel.

MR. MURRAY: To begin with, Your Honor, if Mr. Dalgarn felt that way, why didn't he tell me six months ago, No. 1?

No. 2, I would like to point out to Your Honor that that rule says, when the attorney finds out that he or another attorney ought to testify, that he is a necessary witness, that, you know, he has certain information in his possession, facts that he has to testify to. We don't have that situation here.

And as far as Mr. Lyle upholding our contention of validity and non-infringement, certainly Mr. Dalgarn should know that we are not going to bring any expert in here to say anything but that.

THE COURT: Well, there are many law firms, of course, that have accountants associated with them.

MR. DALGARN: Yes, but this --

THE COURT: And they are very helpful in tax matters.

I think we will permit the witness to testify, but as to what effect this has upon his credibility, that will be up to the court whether this indicates some interest or bias on his part.

But I don't think, under the circumstances here, we will disqualify him. I think the court has some leeway and discretion in this matter, and I do think that perhaps the problem here is that you knew well in advance. So, it isn't a question about a sudden problem coming up in the middle of the trial in this case. We are quite prone to allow lawyers to testify even as to matters of sharply disputed facts, because, otherwise, it means stopping the trial and starting all over again at some other time.

But I think, under the circumstances here, we will permit the testimony of this witness under b(4) as being

permissible within the discretion of the court. But the weight to be given the testimony under these circumstances will be for the Trial of Fact.

MR. DALGARN: Thank you, Your Honor.

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CERTIFICATE OF SERVICE

I hereby certify that three copies each of the foregoing Petition and the appendix have this date been served upon opposing counsel of record by mailing the same by United States mail, postage prepaid and properly addressed.

Date:

Thomas H. Murray
Counsel for Petitioners